

**REMARKS**

Claims 19-36 have been cancelled, and new claims 37-54 have been added. Claims 1-18 have been withdrawn. New claims 37-54 have not been added for reasons of patentability but instead are added to clarify the claimed invention.

**I. RESTRICTION REQUIREMENT**

In response to the restriction requirement, Applicant elects Group II claims with traverse. Applicant has withdrawn claims 1-18 without prejudice. The method of making an interlayer on a roadway, as claimed in claims 37-54, cannot be used to make other and materially different products from the interlayer for placement on a road that is claimed in claims 1-18. For the foregoing reasons, inventions I and II are not distinct and therefore should be able to be prosecuted in the same application.

**II. SECTION 103 REJECTION**

Applicant respectfully submits that claims 37-54 are not anticipated or made obvious by U.S. Patent No. 6,248,396 to Helf (Helf) in view of U.S. Patent No. 3,907,582 to Walter (Walter) and U.S. Patent No. 5,306,750 to Goodrich (Goodrich). Still further, even if these references are combined with U.S. Patent No. 3,891,585 to McDonald (McDonald), claims 37-54 are not anticipated or made obvious.

These references alone or in combination do not disclose or suggest performing a stability test and a fatigue test on a proposed interlayer polymer-modified asphalt mixture in order to better design an interlayer to be placed on a roadway. There is no teaching or

suggestion in these cited references of balancing fatigue and stability properties to design an improved interlayer.

Helf does not teach or suggest performing stability or fatigue tests. Helf's teaching of measuring flexibility in no way suggests or implies measuring fatigue. Flexibility is merely whether a material will bend without breaking whereas fatigue tests determine how a material withstands a large number of bends. There is no suggestion or teaching that Helf's flexibility test is more than one cycle whereas Applicant's claimed fatigue test requires by definition more than one cycle. In a preferred embodiment, as claimed in claim 39, it requires 100,000 cycles. Thus, entirely different properties of a material are measured by these two tests. Further, there is no teaching or suggestion by Helf of using stability and fatigue tests in combination to design an interlayer for a roadway. In fact, Helf does not teach or suggest using any performance test to help define design parameters for making an interlayer, as claimed by Applicant.

Goodrich does not disclose or suggest performing a stability test. Still further, Goodrich is using his fatigue test to show properties of his novel composition after it is laid. In contrast, Applicant is using its fatigue test to design an asphalt interlayer mix. Applicant's fatigue test provides design guidelines for creating the composition of the interlayer. Further, Goodrich provides no teaching or suggestion that it would be advantageous to test the stability along with the fatigue of the proposed interlayer mixture.

Walter does not disclose or suggest performing a fatigue test. Still further, the stability test taught by Walter relates to measuring the stability of a base course after it is constructed on a

road. Walter teaches nothing about using the combination of a stability test and a fatigue test to design an interlayer for a roadway, as claimed by Applicant.

McDonald does not teach or suggest performing a stability test or a fatigue test on polymer-modified asphalt in order to design an interlayer, as claimed by Applicant. Still further, McDonald does not teach or suggest the combination of two performance tests, namely a stability test and a fatigue test, would provide guidance in designing an interlayer.

Applicant respectfully submits that, even if Helf, Goodrich, Walter, and/or McDonald are combined, a prima facie case of obviousness for rejecting the pending claims is not established. As discussed above, the cited references do not disclose or suggest Applicant's claimed invention.

Furthermore, the cited references are not properly combinable. McDonald's pavement repair composition for surfaces should not be combined with Walter's asphaltic pavement base course for replacing sand or stone. Further, neither are analogous art to Applicant's method of making an interlayer. In addition, Goodrich's polymer-linked-asphalt and Helf's liquid mixture that is used with flexible aggregate should not be combined with McDonald or Walter because there is no motivation to combine these references.


Still further, even if the cited references are combined, they do not disclose or suggest Applicant's claimed invention. Namely, they do not disclose or suggest using fatigue and stability tests in combination to develop design parameters for designing an interlayer. The Patent and Trademark Office's burden of establishing a prima facie case of obviousness is not met unless "the teachings from the prior art itself would appear to have suggested the claimed

subject matter to a person of ordinary skill in the art." In re Bell, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993) (quoting In re Rinehart, 189 U.S.P.Q. 143, 147 (C.C.P.A. 1976)). A person of ordinary skill in the art that reviewed these four cited references would not conclude that it would be desirable to perform fatigue and stability tests on a polymer-modified asphalt mixture and then use that data to design an interlayer for placement on a roadway, as claimed by Applicant.

### III. CONCLUSION

In view of the foregoing amendments and remarks, it is respectfully submitted that the claims are now in condition for allowance and eventual issuance. Such action is respectfully requested. Should the Examiner have any further questions or comments which need be addressed in order to obtain allowance, please contact the undersigned attorney at the number listed below. Acknowledgment of receipt is respectfully requested.

Respectfully submitted,

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